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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,282	11/15/2003	Clare L. Hoke JR.		1123
<div>7590      12/13/2007</div> <div>Clare L. Hoke Jr. Suite 11 1318 N. Monte Vista Ave. Upland, CA 91786</div> <div>EXAMINER MURDOUGH, JOSHUA A</div> <div>ART UNIT      PAPER NUMBER</div> <div>3621</div> <div>MAIL DATE      DELIVERY MODE</div> <div>12/13/2007      PAPER</div>				

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/713,282

Applicant(s)

HOKE, CLARE L.

Examiner

Joshua Murdough

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 32-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 32-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Examiner's Notes***

1. Claims 1-12 listed as canceled and claims 13-31 listed as withdrawn have not been previously presented in this application, therefore, they cannot have obtained this status. It is believed that these claims were presented in the parent application (09/610024). Claims from the parent are not inherited by the child and therefore, are not in the instant application at this time. Claims 32-45 are currently pending.

### ***Claim Objections***

2. Claims 32-45 are objected to because of the following informalities: Claim terms should not be capitalized unless a special meaning is attached. (See attached section of "Gregg Reference Manual") Throughout the claims, "Intellectual and Copyrighted Properties," "Servers," "Routers," "Property Rights Management," and "Internet Environment" are capitalized when there is no special meaning given. This makes it unclear as to whether there is supposed to be a special meaning or not. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 32-45 rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

4. The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to

Art Unit: 3621

present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

5. Positive recitations of the required steps and components allow the reader the best understanding of what is being claimed. In the claims of the instant application, the terms often leave the reader struggling to understand the scope of the claims.

6. For example, the phrase "TCI's act as protocols" (Claim 40, line 8) is indefinite, because it is not clear if the TCI's are in fact protocols, or if not, how they are made to act in that capacity. Similarly, the phrases "serve(s) to" (Claim 32, line 13) and "to facilitate" (Claim 36, line 8) are indefinite because they do not positively show what device is performing the action or how it is causing the action to occur.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 43-45 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

8. A "Transaction Code Identifier" (Claim 43, line 1), as claimed, is not one of the four statutory classes of inventions, as it is merely data. Data is not a process, machine, manufacture, nor a composition of matter. Data by itself, is considered a signal, which is, per se, non-statutory, due to its lack of tangibility.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3621

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 32-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Stefik (U.S. Patent 5,629,980).

11. As to claims 32-42, Stefik shows the physical limitations:

computers (Figure 2, #201-#204);

servers, which are digital storage devices (Column 4, lines 9-10)

networks, which include routers (Column 1, lines 25-28);

connected to the Internet (Column 1, line 28);

12. Stefik further shows:

Intellectual property being stored and distributed (digital works, with assigned rights; Abstract);

The digital works having identifiers (Figure 7, #701) allowing them to be tracked and have rights enforced (Columns 9 & 10, lines 50-7);

The validation through a third party of the receiver and owner of the digital work and also the use of a third party to control distribution (Column 43, lines 51-55);

The embedding of the rights into the digital work (Column 23, lines 35-37):

13. As to claims 43-45 Stefik shows:

The digital works having identifiers (Figure 7, #701), the identifiers having two parts, one specific to the creator and one specific to the copy of the work, allowing them to be tracked and have rights enforced (Columns 9 & 10, lines 50-7)

Art Unit: 3621

The validation through a third party of the receiver and owner of the digital work and also the use of a third party to control distribution (Column 43, lines 51-55) ;

***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

15. Grundy (U.S. Patent 5,375,240) shows another system for distribution and identification of intellectual property.

16. Rabne (U.S. Patent 6,006,332) shows a system where usage rights for digital contents are displayed and watermarks are used.

17. This application is a continuation-in-part ("CIP") application of U.S. application no. 09/610024 filed on 29 August 2002. See MPEP §201.08. In accordance with MPEP §609.02 A. 2 and MPEP §2001.06(b) (last paragraph), the Examiner has reviewed and considered the prior art cited in the Parent Application. Also in accordance with MPEP §2001.06(b) (last paragraph), all documents cited or considered 'of record' in the Parent Application are now considered cited or 'of record' in this application. Additionally, Applicant(s) are reminded that a listing of the information cited or 'of record' in the Parent Application need not be resubmitted in this application unless Applicant(s) desire the information to be printed on a patent issuing from this application. See MPEP §609.02 A. 2. Finally, Applicant(s) are reminded that the prosecution history of the Parent Application is relevant in this application.

18. An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed.

Art Unit: 3621

Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

19. A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under "Attorney and Agent Roster." Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U. S. Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450

20. If Applicant does not wish to seek legal representation for the prosecution of this case, it is strongly suggested they take the time to read through the MPEP (Manual of Patent Examining Procedure), particularly chapters 700 and 2100, as they pertain to the instant application. These chapters are directed to the examination and patentability of an application and will give the reader a much better understanding of the patent process, and increase the likelihood of obtaining a worthwhile patent.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Murdough whose telephone number is (571) 270-3270.


The examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joshua Murdough

 12/10/07  
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